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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/609,470

07/01/2003

Atsushi Yasuno

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5514 7590 12/27/2006
FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK, NY 10112

EXAMINER

STOUFFER, KELLY M

ART UNIT

PAPER NUMBER

1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/27/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/609,470

Applicant(s)

YASUNO, ATSUSHI

Examiner

Kelly Stouffer

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-25 is/are pending in the application.
4a) Of the above claim(s) 15-25 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-12 and 14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Regarding the traversal of the restriction requirement, the Examiner notes that the requirement was made final in the previous Office Action dated 7 July 2006. The arguments filed on 10/10/2006 were fully considered but were not found persuasive. Regardless of the intended use of an apparatus by the applicant, a restriction requirement is deemed proper if the apparatus as claimed can be used in a materially different process, such as etching given by the examiner. This process does not have to be claimed by the applicant in order for the restriction requirement to be proper. An apparatus that uses plasma to etch a substrate reads on the applicant's apparatus claims and one of ordinary skill in the art would recognize that etching a substrate is a materially different process from depositing a film on a substrate. Therefore, the restriction requirement is upheld. A complete reply to the final rejection must include cancellation of nonelected claims 15-25 or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

2. Regarding the 35 USC 102 rejection of claims 1-12 and 14 under Sakai et al., and the 35 USC 102 rejection of claims 1-12 and 14 under Moleshi, the arguments filed 10/10/2006 were fully considered but are moot in view of the new grounds of rejection presented below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1-4 recite the limitation of "a deposited film formation process for controlling film formation temperature". This is deemed to be new matter because the specification only provides support for a process to deposit a film and does not indicate that the applicant had possession of an apparatus solely to control film formation temperature. On page 14 of the specification, heaters control the film formation temperature specifically, and the temperature is only to control the deposited film properties. Claims 5-12 and 14 are rejected as being dependant upon rejected base claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moleshi (US 5273609) in view of Chan (US 5653811).

Regarding claims 1-4, Moleshi includes a film formation process for controlling film formation temperature to overcome thermal stress limitations (column 1 lines 49-55 and column 6 lines 3-21) in which a source gas is fed into a discharge space of a reactor and electric power is applied to generate discharge in the discharge space to decompose the source gas, forming a deposited film on a substrate by switching electric power between a first and second discharge means to form a film with semiconductor layers of the same conductivity (columns 7-8 and 10-11 et seq.) Moleshi does not include using a device that has capabilities for moving the substrate through the reactor during film formation to be coated by discharge means disposed within the reactor. Chan teaches using a device that has capabilities for moving the substrate through the reactor during film formation to be coated by discharge means disposed within the reactor in order to sequentially treat more than one substrate and use a plasma source

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attached to the reactor the produced plasmas from specific gases (column 4 lines 8-31 and Figures 5 and 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Moleshi to include using a device that has capabilities for moving the substrate through the reactor during film formation to be coated by discharge means disposed within the reactor as taught by Chan in order to sequentially treat more than one substrate and use a plasma source attached to the reactor the produced plasmas from specific gases.

Regarding claims 5-12 and 14, the process of Moleshi uses multiple plasma sources and senses multiple conditions such as temperature, time, voltage, and current which activate switches that turn the plasma source from one to the other (column 4 lines 5-43, column 8 lines 10 – column 12 line 36, and Figure 2).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Stouffer whose telephone number is (571) 272-2668. The examiner can normally be reached on Monday - Thursday 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Stouffer
Examiner
Art Unit 1762

kms



TIMOTHY MEKS
SUPERVISORY PATENT EXAMINER